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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/649,199	08/27/2003	Bruce Nesbitt	6491800-114	5138

7590 11/04/2005

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EXAMINER

WILLIAMS, KENNETH C

ART UNIT PAPER NUMBER

3739

DATE MAILED: 11/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/649,199	NESBITT, BRUCE	
	Examiner	Art Unit	
	Kenneth C. Williams	3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-67 is/are pending in the application.
- 4a) Of the above claim(s) 9-16, 19-27, 29-38 and 40-67 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-8, 17, 18, 28 and 39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 August 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>11/14/03, 10/26/04</u> | 6) <input checked="" type="checkbox"/> Other: <u>See Continuation Sheet</u> |

Continuation of Attachment(s) 6). Other: Information Disclosure Statement from 4/28/05.

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Species XII, Claims 1-8, 17, 18, 28 and 39 in the reply filed on 10/07/2005 is acknowledged.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "106c" has been used to designate both top coating and spherical particles. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "106d" and "108f" have both been used to designate top coating. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet

submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to because Figure 5C contains an element 52 which should be labeled 522. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

5. In addition to Replacement Sheets containing the corrected drawing figure(s), applicant is required to submit a marked-up copy of each Replacement Sheet including

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annotations indicating the changes made to the previous version. The marked-up copy must be clearly labeled as "Annotated Sheets" and must be presented in the amendment or remarks section that explains the change(s) to the drawings. See 37 CFR 1.121(d)(1). Failure to timely submit the proposed drawing and marked-up copy will result in the abandonment of the application.

Specification

6. The disclosure is objected to because of the following informalities:
 - a. On page 2, line 9, "may used" should be changed to read --may be used--.
 - b. On page 5, line 30, "may any" should be changed to read --may be any--.
 - c. On page 7, line 8, "electrically" should be changed to read --electrical--.
 - d. On page 31, line 9, "more the layers" should be changed to read --more layers--.
 - e. On page 34, line 1, "completed" should be changed to read --completely--.
 - f. On page 35, line 19, "may any" should be changed to read --may be any--.
 - g. On page 38, line 32, "the dried" should be changed to read --then dried--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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9. Claim 18 recites the limitation "the top coating" in last 2 lines of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1-8, 17-18, 28 and 39 are rejected under 35 U.S.C. 102(e) as being anticipated by Greep (U.S. Patent Application Publication No. 20030163125).

a. In regards to Claims 1 and 28, Greep discloses an electrosurgical device comprising "an electrode" (See Figure 1, element 130), "a handle connected to the electrode" (See Figure 1, element 120), "an electrical source in communication with the handle to transfer electrical energy to the electrode for contacting tissue in a body during an electrosurgical procedure" (See Figure 1, element 110), "a conductive substrate" (See Page 3, Paragraph 0035, line 6-14), and "at least one substantially uniform coating applied to said substrate, wherein the coating includes a base material and a plurality of antimicrobial particles interspersed in said base material" (See Page 3, Paragraphs 0041 and 0042).

- b. In regards to Claim 2, Greep discloses an electrosurgical device comprising "the conductive substrate includes a metal" (See Page 3, Paragraph 0043, lines 6-11).
- c. In regards to Claim 3, Greep discloses an electrosurgical device comprising "the metal includes stainless steel" (See Page 3, Paragraph 0043, lines 6-11).
- d. In regards to Claims 4 and 17, Greep discloses an electrosurgical device comprising "at least a portion of the conductive substrate includes an electrically insulative material includes the substantially uniform coating" (See Page 3, Paragraph 0035, lines 14-16).
- e. In regards to Claims 5 and 18, Greep discloses an electrosurgical device comprising "a portion of the conductive substrate underneath the insulative material includes the substantially uniform coating" (See Page 3, Paragraph 0035).
- f. In regards to Claim 6, Greep discloses an electrosurgical device comprising "the base material includes a non-stick material" (See Page 3, Paragraph 0041 and Page 4, Paragraph 0048).
- g. In regards to Claim 7, Greep discloses an electrosurgical device comprising "the non-stick material includes at least one of the non-stick materials selected from the group consisting of: silicone, polytetrafluoroethylene, a fluoropolymer, ceramics and a combination of fluorosilicones" (See Page 4, Paragraph 0048).

h. In regards to Claim 8, Greep discloses an electrosurgical device comprising "the anti-microbial particles include at least one of the group consisting of: silver particles and ceramic" (See Page 3, Paragraphs 0041 and 0042).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

14. Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Greep ~~Greep~~ (U.S. Patent Application Publication No. 20030163125) in view of Greep et al. (U.S. Patent Application Publication No. 20030109864).

In regards to Claim 39, Greep discloses a method comprising "evenly applying a substantially uniform coating to a surface of the conductive substrate, said coating including a base material and a plurality of anti-microbial particles interspersed in the base material" (See Greep Page 3, Paragraphs 0036, 0041, and 0042).

The Greep reference does not disclose, "at least partially curing the substantially uniform coating". Attention is directed to the Greep et al. reference which in an analogous field of endeavor discloses a method of partially curing a base material and filler on a substrate (See Greep et al. Page 2, Paragraph 0031). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method of Greep with the partial curing method of Greep et al. to allow particles to be permanently embedded in the base material.

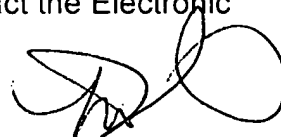
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth C. Williams whose telephone number is (571) 272-8161. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KCW



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